

REMARKS/ARGUMENTS

Claims 1-23 are pending in the present application. Claims 1, 8, 9, 11, 17, and 23 are amended. Claim 7 is cancelled. Support for the claim amendments can be found in the claims as originally filed and in the Applicant's patent application on page 17, lines 5-12. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 101; Claims 17-22

The Examiner rejected claims 17-22 under 35 U.S.C. § 101 as directed towards non-statutory subject matter. Applicant's specification has been amended to overcome the rejection. Thus, claims 17-22 recite tangible subject matter.

II. 35 U.S.C. § 102, Anticipation; Claims 1-23

The Examiner rejected claims 1-23 under 35 U.S.C. § 102 as anticipated by *Shah*, Method and System for Busy Presence State Detection in an Instant Messaging System, U.S. Patent Application Publication No. 2005/0080848, April 14, 2005 (hereinafter "*Shah*"). Claim 7 is cancelled, rendering the rejection against claim 7 moot. This rejection is respectfully traversed with respect to the remaining claims. With regard to claim 1, the Examiner states that:

As to claims 1, 11, and 17, *Shah* teaches a method (and system and program product) in a data processing system for changing a user status in a messaging program (Paragraph [0009] lines 6 - 7 discloses transitioning a presence state of an instant messenger to a busy state), the method comprising:

identifying a number of current conversations open for a user in the messaging program (Paragraph [0072] lines 3 - 4 discloses detecting a computer system activity level and it is clarified in paragraph [0073] lines 18 - 19 that the activity level may include the number of simultaneous chat sessions a given user is participating in); and

setting the user status to busy if the number of current conversations for the user equals a threshold (Paragraph [0075] lines 2 - 5 discloses transitioning the presence state corresponding to a given user to a busy state in response to determining that the detected activity level exceeds the corresponding activity threshold)

Office Action dated September 13, 2007, p. 3 (emphasis in original).

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-*

Clark Corp., 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). In this case, every feature of the presently claimed invention is not identically shown in the cited reference, arranged as they are in the claims.

Amended claim 1, which is representative of amended claims 11, 17, and 23, is as follows:

1. A method in a data processing system for changing a user status in a messaging program, the method comprising:
 - identifying a number of current conversations open for a user in the messaging program;
 - setting the user status to busy if the number of current conversations for the user equals a threshold;
 - responsive to receiving a message while the user status is busy, saving the message without presenting the message;
 - responsive to the user status changing to available, presenting a saved message; and
 - responsive to a sender of the saved message being unavailable, presenting an indication that the sender is unavailable.

Shah does not disclose all of the features of amended claim 1. Specifically, *Shah* fails to disclose the feature of “responsive to a sender of the saved message being unavailable, presenting an indication that the sender is unavailable.” The Examiner cites a portion of *Shah* with respect to the feature of “responsive to the user status changing to available, presenting a saved message,” as recited in original claim 7. Applicant now addresses this portion of *Shah* to show that *Shah* fails to disclose the feature “of responsive to a sender of the saved message being unavailable, presenting an indication that the sender is unavailable,” as recited in amended claim 1. The Examiner cites the following portion of *Shah*:

[0104] In another embodiment, IM client 100 may be configured to detect a transition from a presence state indicative of a busy user state to a presence state indicative of an idle user state, and in response, to notify the associated user of queued instant messaging operations. For example, a user may manually transition his or her presence state from an away state to an online state, or such a transition may occur based on computer system activity status or schedule information as described above. Once the user transitions to an online presence state, queued operations may be delivered, for example in the order they were queued.

Shah, paragraph 104.

Neither the cited portion nor any other portion of *Shah* discloses the feature of responsive to a sender of the saved message being unavailable, presenting an indication that the sender is unavailable. *Shah* discloses a system for detecting a presence state for a user in an instant messaging system. The presence state may depend on an activity level, such as an activity level of the computer hardware being used by the user. Presence states include “busy,” “online,” “away,” and “idle.” *Shah* also discloses queuing messenger operations if the presence state of a user is “busy.” See, *Shah*, paragraph 102. The

cited portion discloses delivering queued messenger operations once the presence state transitions to an “idle” or “online” state. However, the cited portion nowhere discloses presenting any indication regarding the sender of the queued messenger operation.

On the other hand, amended claim 1 recites the feature “of responsive to a sender of the saved message being unavailable, presenting an indication that the sender is unavailable.” The cited portion of *Shah* differs from the claimed feature because the cited portion discloses only delivering queued messenger operations upon a transition in presence state, but nowhere discloses that data regarding the sender of the queued messenger operation is presented. Furthermore, the cited portion does not relate to the availability of the sender of the queued messenger operation, and therefore does not disclose presenting an indication that the sender is unavailable.

For example, the cited portion states, “[o]nce the user transitions to an online presence state, queued operations may be delivered, for example in the order they were queued.” However, the cited statement discloses only the delivery of queued operations once the user transitions to an online presence state, but does not disclose presenting data relating to the sender of the queued operation, let alone presenting an indication that the sender is unavailable. Thus, *Shah* does not reap the benefit of conveying availability data about the sender of the queued messenger operation, such as notifying a user whether a messenger conversation may be initiated with a sender of a message that has been queued for a particular amount of time.

Therefore, *Shah* does not disclose the feature of responsive to a sender of the saved message being unavailable, presenting an indication that the sender is unavailable. Accordingly, *Shah* does not disclose all of the features of amended claim 1, and patentably distinguishes over amended claim 1 in its present form.

Because amended claim 1 is representative of amended claims 11, 17, and 23, the same distinctions between amended claim 1 and *Shah* apply to amended claims 11, 17, and 23. Because claims 2-6, 8-10, 12-16, and 18-22 depend from amended claims 1, 11, and 17, at least the same distinctions between *Shah* and claims 1, 11, and 17 apply for these claims as well. Additionally, claims 2-6, 8-10, 12-16, and 18-22 claim other additional combinations of features not disclosed by the reference.

Furthermore, *Shah* does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. Absent the Examiner pointing out some teaching or incentive to implement *Shah* and the teaching of responsive to a sender of the saved message being unavailable, presenting an indication that the sender is unavailable, as claimed, one of ordinary skill in the art would not be led to modify *Shah* to reach the present invention when the reference is examined as a whole.

Absent some teaching, suggestion, or incentive to modify *Shah* in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the Applicant's disclosure as a template to make the necessary changes to reach the claimed invention.

III. Conclusion

The subject application is patentable over the cited reference and should now be in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

/James O. Skarsten/

James O. Skarsten
Reg. No. 28,346
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Attorney for Applicant

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